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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Titan International, Inc.

Serial No. 76021045

Daniel A. Rosenberg of Davis, Brown, Koehn, Shors &
Roberts, P.C. for Titan International, Inc.

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115 (Tomas Vlcek, Managing Attorney).

Before Quinn, Hohein and Drost, Administrative Trademark
Judges.

Opinion by Drost, Administrative Trademark Judge:

On April 5, 2000, Titan International, Inc.
(applicant) applied to register the mark CONTRACTOR FWD (in
typed form) on the Principal Register for goods ultimately
identified as "tires, namely, tires for vehicles used in
the construction, earthmoving, and mining industries" in
International Class 12.¹

¹ Serial No. 76021045. The application alleges a date of first
use and a date of first use in commerce of January 1, 1994.

The examining attorney² raises three grounds for refusing to register applicant's mark. First, the examining attorney refuses to register applicant's mark under Section 2(d) of the Trademark Act (15 U.S.C. § 1052(d)) because of a registration³ for the following mark for "rubber tires for vehicles" also in International Class 12:

The logo consists of the words "CON-TRAK-TOR" in a bold, blocky, sans-serif font. The letters are outlined with a thick black border, giving it a three-dimensional or stamped appearance. The text is slightly arched upwards from left to right.

The second refusal also is based on Section 2(d) of the Trademark Act. In this refusal, the examining attorney maintains that applicant's mark CONTRACTOR FWD is confusingly similar to three registrations for the mark FWD. One registration is for the mark FWD in typed form for "trucks, fire engines, truck-trailers, trailers, and custom-made vehicles, and parts thereof" in International Class 12.⁴ The second registration is for the mark shown

² The current examining attorney was not the original examining attorney in this case.

³ Registration No. 245,262 issued August 7, 1928, third renewal. Uniroyal Goodrich Tire Company is currently listed as the owner of the registration.

⁴ Registration No. 698,490 issued May 31, 1960, second renewal. The registrant is currently listed as FWD Corporation.

below for "trucks, truck trailers, and custom-made land and amphibious vehicles" in International Class 12.⁵



The third registration⁶ is for the mark shown below for "motor-driven trucks" in International Class 12.

FWD

In the third refusal, the examining attorney requires applicant to disclaim the letters FWD inasmuch as the examining attorney held that the term is merely descriptive of applicant's goods. Section 6(a) of the Trademark Act, 15 U.S.C. § 1056(a).

When the refusals were made final, applicant filed an appeal.

⁵ Registration No. 709,270, issued January 3, 1961, second renewal. FWD Corporation is listed as the owner of the registration.

⁶ Registration No. 107,444, issued November 30, 1915, fourth renewal. FWD Corporation is also listed as the owner of this registration.

In a case involving a refusal under Section 2(d), we analyze the facts as they relate to the relevant factors set out in In re Majestic Distilling Co., 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). See also In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973); and Recot, Inc. v. Becton, 214 F.3d 1322, 54 USPQ2d 1894, 1896 (Fed. Cir. 2000). In considering the evidence of record on these factors, we must keep in mind that "[t]he fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks." Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976).

First Refusal - Registration No. 245,026

We start our analysis with a comparison of applicant's and registrant's marks. Applicant's mark is for the mark CONTRACTOR FWD in typed form. Registrant's mark is for the stylized mark CON-TRAK-TOR. The words CON-TRAK-TOR and CONTRACTOR would be pronounced, at a minimum, very similarly if not identically. While there are differences between the ways the marks would appear because of the hyphens in registrant's mark, they are otherwise similar in appearance. The presence of the letters FWD does not significantly change the pronunciation or appearance of the

mark. The letters appear at the end of applicant's mark and the letters, as will be discussed subsequently, even if not descriptive, clearly have some significance in the field of motor vehicles. If "the dominant portion of both marks is the same, then confusion may be likely notwithstanding peripheral differences." In re Denisi, 225 USPQ 624, 624 (TTAB 1985). See also Wella Corp. v. California Concept Corp., 558 F.2d 1019, 194 USPQ 419, 422 (CCPA 1977) (CALIFORNIA CONCEPT and design held likely to be confused with CONCEPT for hair care products). In this case, the dominant portion of both marks is very similar, if not identical, in meaning and pronunciation, and very similar in appearance.

Some exceptions to this general rule include situations where the common term would not be perceived as distinguishing the source because of its descriptiveness or widespread use or where the marks convey significantly different commercial impressions. Denisi, 225 USPQ at 625. In this case, neither exception applies. We have no basis to conclude that the term "contractor" would not be a distinguishing feature and the meaning of both marks would still be "contractor" with applicant adding the letters FWD. Applicant suggests that only its mark would mean "contractor" because registrant's mark emphasizes the

"trak" portion of the mark. However, we must compare the marks in their entireties and even when the "trak" portion is noticed, ultimately purchasers would see that the entire mark is the phonetic equivalent of "contractor." Inasmuch as applicant's and registrant's common term would likely be pronounced the same, their meaning would be the same. In addition, inasmuch as applicant's mark is depicted in a typed drawing, a difference in typed style cannot be asserted. Squirtco v. Tomy Corp., 697 F.2d 1038, 216 USPQ 937, 939 (Fed. Cir. 1983). Therefore, we conclude that despite the slightly different spellings and the addition of the letters FWD by applicant to its mark, we conclude that the marks are similar in sound, appearance, and meaning, and their overall commercial impressions would be the same.

Another critical factor in any likelihood of confusion analysis is whether the goods of the applicant and the registrant are related. We must consider the goods as they are described in the identification of goods in the application and registration. Octocom Systems, Inc. v. Houston Computers Services Inc., 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990) ("The authority is legion that the question of registrability of an applicant's mark must be decided on the basis of the identification of goods set

forth in the application regardless of what the record may reveal as to the particular nature of an applicant's goods, the particular channels of trade or the class of purchasers to which the sales of goods are directed").

Applicant's goods are identified as "tires, namely, tires for vehicles used in the construction, earthmoving, and mining industries." Applicant has, thus, limited its tires to tires used in these specific industries. The goods in the cited registration are also tires, and they are identified simply as "rubber tires for vehicles." The term "vehicles" is broad enough to include vehicles used in the "construction, earthmoving, and mining industries."

Therefore, we must consider that registrant's and applicant's goods are identical, at least to the extent that both would include rubber tires for vehicles in the construction, earthmoving, and mining industries. To the extent that the goods are not restricted in the registration, we must consider that they move through all normal channels of trade. Schieffelin & Co. v. Molson Companies Ltd., 9 USPQ2d 2069, 2073 (TTAB 1989)

("[M]oreover, since there are no restrictions with respect to channels of trade in either applicant's application or opposer's registrations, we must assume that the respective

products travel in all normal channels of trade for those alcoholic beverages").

Applicant strongly argues that the buyers are sophisticated and the goods are expensive. Assuming that tires for vehicles in these specialized industries are expensive and the purchasers sophisticated, we are not convinced that even these factors demonstrate that there is no likelihood of confusion. We emphasize that the goods are considered to be identical and their channels of trade and purchasers would also overlap. Even "careful purchasers are not immune from source confusion." In re Total Quality Group Inc., 51 USPQ2d 1474, 1477 (TTAB 1999). See also In re Hester Industries, Inc., 231 USPQ 881, 883 (TTAB 1986) ("While we do not doubt that these institutional purchasing agents are for the most part sophisticated buyers, even sophisticated purchasers are not immune from confusion as to source where, as here, substantially identical marks are applied to related products"). "Human memories even of discriminating purchasers ... are not infallible." In re Research and Trading Corp., 793 F.2d 1276, 230 USPQ 49, 50 (Fed. Cir. 1986), quoting, Carlisle Chemical Works, Inc. v. Hardman & Holden Ltd., 434 F.2d 1403, 168 USPQ 110, 112 (CCPA 1970). Even sophisticated purchasers are likely to be confused

when marks as similar as the marks here are used on identical products. Recommendations from users to the purchasers of these tires could be made orally, which greatly increases the likelihood that these marks used on identical tires would be confusingly similar. Also, because the marks appear very similar and have virtually the same meaning, their commercial impression would likewise be similar. Prospective purchasers would likely assume that there was at least some association or sponsorship between the marks CONTRACTOR FWD and CON-TRAK-TOR when these marks are used on the same goods.

[I]t is enough that goods or services are related in some manner or that circumstances surrounding their marketing are such that they would be likely to be seen by the same persons under circumstances which could give rise, because of the marks used thereon, to a mistaken belief that they originate from or are in some way associated with the same producer or that there is an association between the producers of each parties' goods or services.

In re Melville Corp., 18 USPQ2d 1386, 1388 (TTAB 1991).

Thus, we compare registrant's mark CON-TRAK-TOR (stylized) with applicant's mark CONTRACTOR FWD and we consider that both marks are for the same goods, i.e., tires for construction, earthmoving, and mining vehicles. We conclude, in view of this, that confusion is likely in this case. Our conclusion is buttressed by the principle that when "marks would appear on virtually identical goods

or services, the degree of similarity necessary to support a conclusion of likely confusion declines." Century 21 Real Estate Corp. v. Century Life of America, 970 F.2d 874, 23 USPQ2d 1698, 1701 (Fed. Cir. 1992).

Second Refusal - Registration Nos. 107,444; 698,490; and 709,207

We reach the opposite conclusion concerning the issue of whether applicant's mark for the identified goods is confusingly similar to the three cited FWD registrations for trucks and other vehicles. Here, the goods are not identical. Applicant's goods are tires for vehicles in the construction, earthmoving, and mining industries. Registrant's goods are "motor-driven trucks" (No. 107,444); "trucks, fire engines, truck-tractors, trailers, and custom-made vehicles, and parts thereof" (No. 698,490); and "trucks, truck tractors, and custom-made land and amphibious vehicles" (No. 709,270). While there obviously is a relationship between tires for trucks and trucks, the goods themselves are not identical.

When we compare the marks CONTRACTOR FWD and FWD (typed, stylized, and with a design), we apply the same test we used previously. If "the dominant portion of both marks is the same, then confusion may be likely notwithstanding peripheral differences." Denisi, 225 USPQ

at 624 (TTAB 1985). Here, while FWD would clearly be the dominant part of registrant's marks, it is not the dominant part of applicant's mark, which we have already found to be the word "contractor." We find that both Denisi exceptions (225 USPQ at 625) are applicable here. First, as will be discussed subsequently, FWD is a term or abbreviation with a recognized meaning in association with vehicles, which limits its distinctiveness. Second, the addition of the dominant term CONTRACTOR to the mark CONTRACTOR FWD creates a significantly different commercial impression than the mark FWD alone. Therefore, we conclude that there is no likelihood of confusion between applicant's mark and the three cited registrations for FWD when the marks are used on the identified goods.

Third Refusal - Disclaimer of FWD

The last issue in this case is whether the examining attorney properly required applicant to disclaim the term FWD because it is merely descriptive for applicant's tires. A term is merely descriptive if it immediately describes the ingredients, qualities, or characteristics of the goods or services or if it conveys information regarding a function, purpose, or use of the goods or services. In re Abcor Development Corp., 588 F.2d 811, 200 USPQ 215, 217 (CCPA 1978). See also In re Nett

Designs, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001); In re MBNA America Bank N.A., 340 F.3d 1328, 67 USPQ2d 1778, 1780 (Fed. Cir. 2003) (A "mark is merely descriptive if the ultimate consumers immediately associate it with a quality or characteristic of the product or service"). To be merely descriptive, a term need only describe a single significant quality or property of the goods. In re Gyulay, 820 F.2d 1216, 3 USPQ2d 1009, 1009 (Fed. Cir. 1987); Meehanite Metal Corp. v. International Nickel Co., 262 F.2d 806, 120 USPQ 293, 294 (CCPA 1959). We look at the mark in relation to the goods or services, and not in the abstract, when we consider whether the mark is descriptive. Abcor, 200 USPQ at 218.

The examining attorney argues that FWD "describes the type of vehicles on which the applicant's tires are used, namely, four-wheel drive or front-wheel drive vehicles." Examining Attorney's Brief at 12. The examining attorney has submitted evidence from an acronym dictionary that supports the fact that FWD is an abbreviation for either "front wheel drive" or "four wheel drive."⁷ Applicant, on

⁷ We grant the examining attorney's request to take judicial notice of definitions of "front wheel drive" and "four wheel drive."

the other hand, points out that the same acronym dictionary indicates that another meaning for the letters FWD is "forward." Also, applicant notes that the three cited registrations for FWD marks for vehicles do not contain a disclaimer or any other indication that these FWD marks have acquired distinctiveness.

The term FWD is an acronym for "front wheel drive" and "four wheel drive." However, the goods in the application are not vehicles but tires. Merely because a term has a descriptive meaning for a vehicle, it does not mean that it is descriptive for all parts associated with the vehicle. For example, the terms "automatic" and "manual" describe the transmissions in a vehicle, but without more evidence, they would not describe the tires or the carpets of the vehicle. There is certainly a possibility that tires for vehicles in the construction, earthmoving, and mining industries are described by whether they are appropriate for front-wheel, rear-wheel, or four-wheel drive vehicles. However, there is no evidence of this in the record.

Our controlling precedent requires us to resolve any doubts we may have on the question of descriptiveness in the applicant's favor. In re Morton-Norwich Products, Inc., 209 USPQ 791, 791 (TTAB 1981) (The Board's practice is "to resolve doubts in applicant's favor and publish the

mark for opposition"). In this case, we have our doubts as to whether FWD is merely descriptive for applicant's tires, and therefore, we resolve those doubts in applicant's favor.

Decision: The examining attorney's refusal to register applicant's mark because of Registration Nos. 107,444; 698,490; and 709,270 is reversed. The refusal to register applicant's mark CONTRACTOR FWD without a disclaimer of the term FWD is reversed. The examining attorney's refusal to register applicant's mark on the ground that it is likely to cause confusion with the mark for the identified goods in Registration No. 245,262 is affirmed.